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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,198	05/14/2001	Rudolf H. Aebersold	P-IS 4693	2506

41552 7590 04/11/2005
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EXAMINER

CEPERLEY, MARY

ART UNIT PAPER NUMBER

1641

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/858,198	Applicant(s) AEBERSOLD ET AL.	
	Examiner Mary (Molly) E. Ceperley	Art Unit 1641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on 24 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) They raise new issues that would require further consideration and/or search (see NOTE below);
(b) They raise the issue of new matter (see NOTE below);
(c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached letter. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 76-86,90,92-99,103,105-140 and 142.
Claim(s) withdrawn from consideration: 87-89,91,100-102,104 and 141.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached letter.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. Other: _____.

Mary (Molly) E. Ceperley
Primary Examiner
Art Unit: 1641

Art Unit: 1641

1) Regarding the change of inventorship:

A statement under 37 CFR 1.48(a)(5) {agreement to change in inventorship} must be filed by each of the co-assignees University of Washington and Applera (final rejection, paragraph **1)b**). For this application, "the assignee" referred to in 37 CFR 1.48(a)(5) is composed of co-assignees Institute for Systems Biology, the University of Washington and Applera.

2) The rejection under 35 USC 112, first paragraph, is maintained for the reason stated in paragraph **7)** of the final rejection and as originally stated in paragraph **5)** of the April 07, 2003 Office action.

Applicant's arguments filed March 24, 2005 have been fully considered but they are not persuasive. Applicant again reiterates that different types of cleavable groups, tags and reactive groups are described in the specification. However, applicant does not address the fact that enablement is lacking for the preparation and use of a variety of configurations and chemistries which are encompassed by the claim language. See the first two paragraphs of page 3 of the April 07, 2003 Office action, in particular the last five lines of the second paragraph (referred to in paragraph **7)** of the final rejection).

3) The rejection of claims 121-140 and 142 is maintained for the reason stated in paragraph **5)** of the final rejection (35 USC 112, second paragraph). The proposed amendments to claims 121, 138 and 142 would render the claims indefinite and confusing. Although a specific chemical structure is provided in the proposed amendments, there is no indication of which parts of the molecule constitute "a chemical group comprising the photocleavable functional group, leucine tag and sulfhydryl reactive group" (no antecedent basis in the chemical formula for the terms in question). An amendment to the claims would be entered which would **a)** provide the same structural formula, **b)** would delete any reference to the "chemical group" and the "leucine tag" **c)** would designate the "reactive group" as being the "I" moiety, and **d)** would specifically designate where the "isotope tag" is present in the formula.


Art Unit: 1641

4) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 07,2005


Mary (Molly) E. Ceperley
Primary Examiner
Art Unit 1641